

## **REMARKS**

The Applicants respectfully request reconsideration in view of the following remarks and amendments. Claim 28 have been amended. Claims 1-15 were previously cancelled. Claims 16-27 have been withdrawn. Claim 30 has been added. Accordingly, claims 28-30 are pending in the Application.

### **I. Election of Claims**

The Examiner states that the current application contains two groups of inventions and the Applicant must elect one group for examination. In response, the Applicant selects Group 2 including claims 28 and 29 without traverse for examination purposes.

### **II. Claim Rejections – 35 U.S.C. §112**

Claim 28 is rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Examiner alleges that claim 28 recites a proximal and distal portion as well as an axial direction without establishing a frame of reference for proximity or an axis thus rendering the claim indefinite. See Office Action, Page 4.

In response, the Applicants have amended claim 28 to recite “the projecting band includes a ring-like proximal end portion which projects from the inner circumferential wall of the gasket main body to extend in a direction substantially perpendicular to an axial direction of the gasket main body.” This amendment is supported, for example, by page 35, lines 7-11 and page 27, lines 3-6 of the Specification as filed. Further, the Applicants submit that this amendment clearly establishes a frame of reference for the proximal portion, the distal portion and the axial direction in relation to the cylindrical gasket main body of claim 28. Thus, claim 28 is no longer indefinite. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejection of claim 28 under 35 U.S.C. § 112, second paragraph.

### **III. Claim Rejections – 35 U.S.C. §102**

Claims 28 and 29 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,693,446 issued to Orlosky *et al.* (“Orlosky”).

To anticipate a claim, the Examiner must show that a single reference teaches each of the elements of that claim. Thus, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In regard to the rejection of claim 28 under 35 U.S.C. § 102, this claim has been amended to recite:

“the projecting band includes a ring-like proximal end portion which projects from the inner circumferential wall of the gasket main body to extend in a direction substantially perpendicular to an axial direction of the gasket main body a tapered distal end portion which extends in a direction substantially parallel to the axial direction of the gasket main body, and a bent portion bend-connecting the proximal end portion and the distal end portion,

the proximal end portion flexes more largely than the distal end portion around the bent portion as a border when pushed from the distal end portion side downward along the axial direction of the gasket main body,

the incorporating step comprises the steps of elastically deforming the gasket main body in the diameter-enlarging direction,

holding at least one of the first mold and the second mold by pressing a circumferential surface of said one mold in a diameter-reducing direction with a restoring force of elastic deformation, and

when holding said one mold, bringing a vertex of the distal end portion into linear contact with the lens forming surface of said one mold by virtue of the fact that the distal end portion undergoes a smaller flexure in a direction perpendicular to the axial direction of the gasket main body than a flexure undergone by the proximal end portion in the axial direction of the gasket main body.”

These amendments are supported, for example, by page 35, lines 7-11, page 27, lines 3-6, page 31, line 22 through page 32, line 6, and page 32, lines 10-18 of the Specification as filed. The Applicants submit that Orlosky fails to teach each element of amended claim 28.

More specifically, Orlosky does not teach the bent portion of amended claim 28 because the arms 42 and 44 of Orlosky do not have any part or portion analogous to the bent portion of amended claim 28. Also, Orlosky has its distal end portion inclined at an angle nearer to a direction substantially perpendicular to an axial direction and thus is distinctly different from the distal end portion recited in amended claim 28 which extends in a direction substantially parallel to the axial direction of the gasket main body.

Further, Orlosky, fails to disclose “the proximal end portion flexes more largely than the distal end portion around the bent portion as a border when pushed from the distal end portion

side downward along the axial direction of the gasket main body” as recited in amended claim 28. Instead in Orlosky, when molded halves are fit within a gasket as seen in Figure 4 of Orlosky, the arms 42, 44 have their distal end portions flexed in the axial direction of the gasket main body without deformation of the proximal end portion. In contrast, the proximal end portion of amended claim 28 flexes. Thus, Orlosky fails to teach this element of amended claim 28.

Furthermore, as is also clearly seen in Figure 4 of Orlosky, when the mold halves are fit within a gasket, the proximal end portion does not undergo deformation with the distal end portions being flexed in the axial direction of the gasket main body as recited in amended claim 28. As a result, the molding surfaces of the mold halves 18, 20 are in contact with the arms 42, 44 in a certain range of width on the inclined surfaces of the arms 42, 44 on the sides of the respective openings at the opposite end of the gasket. However, Orlosky does not have the molding surfaces of the mold halves 18, 20 brought into linear contact with the tips of the arms 42, 44 when the mold halves are fit within the gasket as the spectacle lens manufactured by the method of amended claim 28 does. Also in this respect, Orlosky fails to disclose “when holding said one mold, bringing a vertex of the distal end portion into linear contact with the lens forming surface of said one mold by virtue of the fact that the distal end portion undergoes a smaller flexure in a direction perpendicular to the axial direction of the gasket main body than a flexure undergone by the proximal end portion in the axial direction of the gasket main body.”

The recited elements of amended claim 28 provide the following advantages:

(i) In a state where a mold is incorporated into a gasket, the distal end portion is brought into linear contact with the molding surface of the mold to thereby produce a high surface pressure there.

(ii) After a lens is molded, resin tailings adhering to the molding surface of the mold removed from the gasket remain linear and according to a portion where the distal end portion of the projecting band was kept in contact with the molding surface of the mold in the course of molding the lens, so that a contact area of the resin tailings is minimized to allow easy removal from the molding surface of the mold.

(iii) The variation in contact pressure acting between the mold and the projecting bands is small for a distance over which the mold is urged against the projecting band and a moderate

contact pressure can be exerted throughout the entire circumference of the lens molding surface. Additionally, the problem that the mold is pushed back by the projecting band can be alleviated.

In contrast, since Orlosky does not have its molding surfaces of the mold halves 18, 20 brought into linear contact with the tips of the arms 42, 44 when the mold halves are fit within the gasket, Orlosky cannot have the foregoing advantages of amended claim 28. Further, in Orlosky, the repellant forces of the proximal end portions of the arms 42, 44 will increase rapidly as the distance over which the mold halves 18, 20 are urged against the projecting band increases.

In view of the foregoing, Orlosky fails to teach each element of amended claim 28. Thus, Orlosky cannot maintain a rejection under 35 U.S.C. § 102. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejection of claim 28 under 35 U.S.C. § 102.

In regard to claim 29, this claim recites “in a portion where at least one of the first mold and the second mold is to be incorporated, an inner circumferential surface of the gasket main body has an inner diameter smaller than an outer diameter of said one mold, and a taper surface that spreads toward an opening of the gasket main body, and when holding said one mold, bringing the taper surface into strongest contact with a circumferential edge of said one mold on a lens molding surface side thereof.” The Applicants submit that Orlosky fails to teach these elements of claim 29.

More specifically, as shown in Figures 2-4 and described in column 5, lines 31-40 of Orlosky, the inner circumferential surface of the gasket of Orlosky is tapered in a direction reverse to the gasket of claim 29. Specifically, Orlosky fails to teach “a taper surface that spreads toward an opening of the gasket main body” as recited in claim 29.

Further, due to this structural feature of Orlosky, the contact between the circumferential edge surface of the mold and the inner circumferential surface of the gasket will be strongest where the circumferential edge of the mold on the opposite side of the lens molding surface is in contact with the inner circumferential surface of the gasket, as is apparent from Figure 4 of Orlosky. Thus, Orlosky does not teach “when holding said one mold, bringing the taper surface into strongest contact with a circumferential edge of said one mold on a lens molding surface side thereof” as recited in claim 29.

Further, the method of claim 29 provides several advantages in comparison to method of the prior art. According to claim 29, if a lens raw material liquid (monomer solution) is injected into a cavity of the mold in a state where the mold is incorporated into the gasket, the monomer solution entering in between the circumferential edge surface 3c of the mold and the inner circumferential surface of the gasket is stably held in a gap between the circumferential edge of the mold on the side of the lens forming surface 3b and the trapper surface of the inner circumferential surface of the gasket, so that it is hard for ambient air to ingress into the cavity in between the circumferential edge surface 3c of the mold and the inner circumferential surface of the gasket. Thus, based on this ambient air restriction, bubble defects can be greatly reduced.

However, in Orlosky the inner circumferential surface of the gasket is tapered in a direction reverse to the gasket of claim 29. Thus, the monomer solution entering between the circumferential edge surface of the mold and the inner circumferential surface of the gasket is stably held in a gap between the circumferential edge of the mold on the opposite side of the lens forming surface and the inner circumferential surface of the gasket. Consequently, ingress of ambient air in between the circumferential edge surface of the mold and the inner circumferential surface of the gasket will be facilitated. Thus, the method of Orlosky cannot realize the above advantages.

In view of the foregoing, Orlosky fails to teach each element of claim 29. Thus, Orlosky cannot maintain a rejection under 35 U.S.C. § 102. Accordingly, the Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 29 under 35 U.S.C. § 102.

#### **IV. New Claim**

The Applicant submits new claim 30 for consideration. New claim 30 includes elements analogous to those of claims 28 and 29. For at least the reasons provided above in regard to claims 28 and 29, each element of new claim 30 is not taught by Orlosky. Accordingly, the Applicant respectfully requests allowance of this claim at the Examiner's earliest convenience.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.


### PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on March 17, 2009, Applicants respectfully petition Commissioner for a one (1) month extension of time, extending the period for response to August 17, 2009. The amount of \$130.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(1) large entity will be charged to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP


Dated: 8/3/09

By:   
Eric S. Hynan / Reg. No. 30,139

1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040  
Telephone (408) 720-8300  
Facsimile (408) 720-8383

#### **CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on the date noted below.

 8/6/09  
Jessica M. Huester Date